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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/596,165	06/02/2006	Scrivas Gutta	US030469US2	3089
22885 7590 11/05/2008 MCKEE, VOORHEES & SEASE, P.L.C. 801 GRAND AVENUE SUITE 3200 DES MOINES, IA 50309-2721				
EXAMINER				
VO, CECILE H				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/596,165

**Applicant(s)**

GUTTA ET AL.

**Examiner**

CECILE VO

**Art Unit**

2169

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 July 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4 and 6-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 6-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date: \_\_\_\_\_

### **DETAILED ACTION**

1. This Office Action is in response to the Applicants' amendment received on 07/29/2008.

#### **Claim Status**

2. Claim 1 is amended.
3. Claims 5 and 16-23 are canceled.
4. Claims 1-4 and 6-15 are currently presenting for examination, with claim 1 being independent.

#### **Specification**

5. Applicants' amendment to objection of Specification is acknowledged. Therefore, objection to the Specification is withdrawn.

#### **Claim Objections**

6. Applicants cancel claims 16-21. Therefore, objections to claims 16-21 are withdrawn.

#### **Claim Rejections – 35 USC §101**

7. Applicant's amendment to rejections of claim 1 under 35 U.S.C 101 is acknowledged. However, Examiner is not persuaded. Claim 1 recites "*allowing*", "*allowing*" and "*determining*" which are not qualify as a statutory process because the claim does not transform underlying subject matter nor it is tied to another statutory class, as such the claim is not statutory. Therefore, the Examiner maintains the rejection to claim 1.
8. Applicants cancel claims 16-21. Thus, rejections to the claims are withdrawn.

9. This action has been made **FINAL**.

***Claim Rejections - 35 USC § 112***

10. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

11. Claims 1-4 and 6-15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 1 the limitation "*the viewer's data receiving apparatus*", in line 3, is not supported by the original disclosure. Therefore, the limitations that belong to "*viewer's data receiving apparatus*" in the claim(s) will not be addressed since the examiner unable to determine the metes and bounds of the limitations.

12. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

13. Claims 1-4 and 6-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "*the viewer's data receiving apparatus*" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claims 2-4 and 6-15 are rejected for the same reason, due to their dependence on the above rejected claim.

***Claim Rejections - 35 USC § 101***

14. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

15. Claims 1-4 and 6-15 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 1 recites "*allowing*", "*allowing*" and "*determining*" which are not qualify as a statutory process because the claim does not transform underlying subject matter nor it is tied to another statutory class. To qualify as a statutory process, the claim should positively recites the other statutory class (e.g. the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state (see MPEP 2106.IV.B and 2106.IV.C; and also see *Diamond v. Diehr*, 450 U.S. at 175, 184 (1981); *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972); and also see *in re Stephen W. Comiskey*, 499 F.3d 1365; 2007 U.S. App. LEXIS 22414; 84 U.S.P.Q.2D (BNA) 1670).

Claims 25-26 are rejected for the same reason, due to their dependence on the above rejected claims.

***Claim Rejections - 35 USC § 102***

16. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

17. Claims 1-4 and 6-15 rejected under 35 U.S.C. 102(e) as being anticipated by Schaffer et al. (hereinafter referred to as Schaffer), US Pub. Number 2006/0026642 A1.

The applied reference has a common Assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Regarding claim 1, Schaffer discloses a method for generating a recommendation of at least one television program for a viewer (see abstract, lines 1-5), the method comprising:

allowing the viewer's data receiving apparatus to be used to access a plurality of user's apparatus at locations remote from that at which the viewer is located (e.g. The audience predictor (as *viewer's data receiving apparatus*) can collect the viewing histories, by directly sampling the program choices of each user or by receiving a viewing history over a network from the set-top terminal or television of each user, §0026, lines 1-5);

allowing the viewer's data receiving apparatus to communicate with a selection of the user's apparatus to allow data representing, at least one of a negative and positive example feedback from one or more selected other users apparatus to be received (e.g. The audience predictor can communicate with the set-top terminal or television of each user in any known manner, including one or more wired or wireless links (or both). While the present invention is illustrated herein in the context of television programming predictions, the present invention can be applied to any automatically generated recommendations that are based on an evaluation of user behavior, such as a viewing history or a purchase history, §0026, lines 5-13. Wherein, the viewing histories use to generate user profiles; and user profile provides corresponding positive and negative program example, §0036, lines 1-3); and

determining a recommendation for at least one television program to be watched in the future by the viewer based on at least one of the received negative and positive examples feedback (e.g. the present invention can be applied to any automatically

generated recommendations that are based on an evaluation of user behavior, such as a viewing history or a purchase history, §0026, lines 10-13);

said determination of the recommendation performed at the viewer location utilizing a processor provided as part of the viewer's data receiving apparatus (e.g. The audience predictor 100 may be embodied as any computing device, such as a personal computer or workstation, that contains a processor 150, §0027, lines 1-3).

Regarding claim 2, Schaffer discloses the method further comprising generating a user profile for the user based on previous behavior of the user, wherein the determining comprises determining the recommendation based on the negative example and the user profile (e.g. the profiling process processes the viewing histories to generate the corresponding user profiles, §0029, lines 1-2).

Regarding claim 3, Schaffer further discloses wherein the generating of the user profile comprises generating an implicit user profile (As shown in Fig. 3, the implicit user profile 300 contains a plurality of records 305-313 each associated with a different program feature, §0035, lines 2-4).

Regarding claim 4, Schaffer further discloses wherein the determining comprises determining the recommendation based on the negative and positive examples (§0045, lines 3-6).



Claim 5 is cancelled.

Regarding claim 6, Schaffer discloses the method further comprising:  
mapping the negative example to an electronic program guide database of the user (§0025, lines 3-7); and  
determining an equivalent negative example for the user from the electronic program database (e.g. the program recommendation process generates program recommendation scores for the programs in a time period of interest, based on the feature counts in the user profiles, §0045, lines 3-6).

Regarding claim 7, Schaffer discloses the method further comprising:  
mapping the positive example to an electronic program guide database of the user (§0025, lines 3-7); and  
determining an equivalent positive example for the user from the electronic program database (§0045, lines 3-6).

Regarding claim 8, Schaffer discloses the method further comprising determining the one or more other users (e.g. a number of users, §0025, line 5).

Regarding claim 9, Schaffer further discloses wherein the determining comprises selecting the one or more other users based on geographical location of the one or

more other users (e.g. selected for the user based on his or her demographics, §0036, lines 13-14).

Regarding claim 10, Schaffer further discloses, wherein the determining comprises selecting the one or more other users based on a similarity of likes and/or dislikes with the one or more other users (§0044, lines 1-7).

Regarding claim 11, Schaffer further discloses wherein the determining comprises selecting the one or more other users by the user (§0049, lines 1-6).

Regarding claim 12, Schaffer further discloses, wherein the selecting comprises: presenting a plurality of other users to the user (e.g. As shown in Fig. 1 the audience predictor 100 uses the raw viewing histories of a number of users to predict the size of an audience, §0025, lines 3-6); and

the user selecting from among the plurality of other users to determine the one or more other users (e.g. Fig. 3 is a table illustrating an exemplary implicit user profile contains a plurality of records each associated with a different program feature, §0035, lines 1-4).

Regarding claim 13, Schaffer further discloses, wherein the presenting comprises presenting the plurality of users based on geographical location of the one or more other users (§0021, lines 1-6).

Regarding claim 14, Schaffer further discloses, wherein the presenting comprises presenting the plurality of users based on a similarity of likes and/or dislikes of the one or more other users (e.g. Fig. 4 is a table from the program database of figs 1 and 2, with field 480 is record and indication of the predicted audience as determined by the audience prediction process, §0038, lines 1-2 ad 0039) .

Regarding claim 15, Schaffer further discloses, wherein the selecting comprises the user indicating the one or more other users (§0026, lines 1-5).

Claims 16-23 are cancelled.

### ***Response to Arguments***

18. Applicant's arguments filed 07/29/2008 have been fully considered but they are not persuasive.

19. As to Applicants' assertion that amended claim 1 is "*a method claim generating recommendations of television programming for a viewer*". Examiner respectfully submits that the amended claim 1 does not include the "*generating*" step. Therefore, it is not qualify as a statutory process under 35 USC §101 because the claim does not transform underlying subject matter nor it is tied to another statutory class. See the rejection under §101 above.

20. As to Applicants' assertion that *"in the prior art there is no processing or recommendations being made at the viewer location"*. The Examiner respectfully disagrees. The prior art has been clearly disclosed by Fig. 6 a flow chart describing an exemplary profiling process used by the audience predictor. Wherein, the audience predictor referred to as *"viewer's data receiving apparatus"* or *"viewer location"*.

For the reasons set forth above, the teachings of Schaffer still apply to amended independent claim 1; therefore, the rejection of the claims under 35 USC 102(e) is maintained.

### ***Conclusion***

21. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CECILE VO whose telephone number is (571)270-3031. The examiner can normally be reached on Mon - Thu (9AM - 5:00PM EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tony Mahmoudi can be reached on 571-272-4078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

October 28, 2008

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Examiner  
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